

Office Action Summary

Application No.

10/580,684

Applicant(s)

HERRERA ORENDAIN ET AL.

Examiner

Aaron J. Kosar

Art Unit

1651

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 5/26/2006

DETAILED ACTION

Claims 4-6 are pending and have been examined on their merits.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on May, 26, 2006, has been considered by the Examiner and placed in the application file; however, the reference of LAUMER (FR 2553098 A) is a foreign language document and has been considered only to the extent of the English-language abstract or to the extent the relevance of the document has been referenced in the specification. The IDS has been annotated to indicate the extent to which the reference of Laumer has been considered.

Claim Objections

Claims 4-6 are objected to because of the following informalities: The claims contain elements to which emphasis has been added by the use of underlining said elements. Whereas amendments may present underlined material, said underlining is reserved exclusively for the purpose of marked-up claims to indicate amended (added) subject matter to the claims.

This objection, however, may be overcome by amending the claims to recite the de-emphasized subject matter. For example, in claim 6, page 7, line 24: to correct the term “cooking ovens” an amendment to the claims of “cooking ovens cooking ovens” in the marked-up amendment will appear as “cooking ovens” in the subsequent clean version.

Claim 4-6 are objected to for not ending in a period. MPEP § 804.01(m) states that, “Each claim begins with a capital letter and ends with a period (emphasis added). Periods may not be used elsewhere in the claims except for abbreviations. See *Fressola v. Manbeck*, 36

USPQ2d 1211 (D.D.C. 1995).” In the instant case the claims recite paragraphs of claims (several sentences each) instead of a single sentence per claims.

Claims 4-6 are objected to because of the following informality: The claims are not in compliance with 37 CFR § 1.75(i) which states, “Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps (See 37 CFR 1.75 and MPEP 608.01(i)-(p)).

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4-6 are rejected under 35 U.S.C. 101 because the claims are drawn to a process of treating stillage (method of using); however, the claims do not recite active steps and are only defined by the apparatus recited therein. The claims are rejected because the claims are drawn to two classifications of invention (method of using vs. apparatus), each of which is a patentably distinct invention, within a single claim and/or a series of dependent claims, although Applicant may only claim one invention in a claim/series of dependent claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-6 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by recited active method steps, for the reasons set forth above one skilled in the art clearly would not know how to use the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if the invention comprises more than one process. Furthermore, the claims are also drawn to both an apparatus and a process using the apparatus, which are of a different statutory classification of invention. Thus two invention classifications are proposed in a single claim/dependency of claims though the claims are required to claim only one (class of) invention per claim/dependency of claims. One of skill would not be apprised as to the subject matter embraced by the claims and would not be able to determine the metes and bounds of the claims, rendering the claims indefinite.

Claims 4-6 are rejected as being an incomplete method (process) for omitting essential steps. While all of the technical details of a method need not be recited, the claims should include enough information to clearly and accurately describe the invention and how it is to be practiced. The minimum requirements for method steps minimally include the active steps of a *contacting step* in which the reaction of the sample with the reagents necessary for the assay is recited, a *detecting or reacting step* in which the reaction steps necessary for the claimed reaction/transformation are effected, and a *correlating/concluding step* describing how the active

steps of the method allow for the result. Also, claims are incomplete in the absence of a recovery step for the product produced. In the instant claims, no active step is recited, rendering the claims indefinite, as one of skill would not be apprised as to the method steps required by the method.

While there is no specific rule or statutory requirement which specifically addresses the need for a recovery step in a process of preparing a composition, it is clear from the record and would be expected from conventional preparation processes that the product must be isolated or recovered. Thus the claims fail to particularly point out and distinctly claim the “complete” process since the recovery step is missing from the claims. The metes and bounds of the claimed process are therefore not clearly established or delineated..

Please note that phrases including the phrase “can be” as well as passive voice or past tense constructs (e.g. “is discharged”), are not active steps and, therefore, do not indicate whether the elements are required or merely exemplary of the claimed process/method (versus for example an active step of “discharging”).

Appropriate correction is required.

Conclusion

The instant claims appear to be a literal/narrative translation of the foreign language document; however, the claims are deficient so as to preclude further examination on the merits of the instant claims or a reasonable search of the prior art by the examiner.

Applicant is required to submit an amendment which clarifies the claims so that the examiner may make a proper comparison of the invention with the prior art.

Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

Accordingly, a few potential references have been cited on a PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Kosar whose telephone number is (571) 270-3054. The examiner can normally be reached on Monday-Thursday, 7:30AM-5:00PM, ALT. Friday, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aaron Kosar
Examiner, Art Unit 1651